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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,049

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Martin Beck

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EXAMINER

CHAPMAN, GINGER T

ART UNIT

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3761

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DELIVERY MODE

12/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,049	Applicant(s) BECK ET AL.	
	Examiner Ginger T. Chapman	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) 3-11, 17-20, 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 15 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>02/12/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1, 2 and 15, directed to a hydrogel, in the reply filed on August 29, 2008 is acknowledged. The traversal is on the ground(s) that the novelty of the invention is defined in the claims of both Group I and Group II and therefore Group I and Group II are not two independent and distinct inventions because the hydrogels and processes of preparing the hydrogels are closely related and therefore searches for both would not present a serious burden on the examiner.
2. This is not found persuasive because of the reasons set forth in the Election/Restriction requirement mail date August 12, 2008, wherein the different status and different classification of the groups of invention have been identified. Applicants' traversal is also not found persuasive because the consideration of undue burden is one that must be made by the Examiner, Applicants argument that the search of one invention may result in a search of the other inventions has been considered, but is not persuasive insofar as the searches are not coextensive and additional search would, of necessity, be required for the combinations of inventions. Applicant has not pointed out wherein either (1) the reasons advanced by examiner to establish distinctiveness between the inventions as claimed and grouped or (2) the evidence of separate status, classification and/or search are in error.
3. Applicant points out that the preliminary amendment to the claims, file date April 14, 2006, added new claims 17-21, directed to methods of absorbing blood and body fluids, were not included in the restriction requirement; however Applicant elects the product claims as set forth in the requirement.

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4. The examiner notes that the method claims would comprise Group III as follows:
5. Inventions Group I and Group II are related as process of making and product made. See Election/Restriction requirement, mail date August 12, 2008 for detailed analysis as to the definition of these groups and why restriction is proper.
6. Inventions Group I and Group III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used to absorb blood and body fluids in food processing such as for meat packaging and commercial kitchen, for other liquids in agricultural and landscaping plant husbandry, such as for mosquito control.
7. The examiner further notes that Applicant Remarks in reply to the restriction requirement states that the preliminary amendment added new claims 17-21, however, the preliminary amendment added claims 17-23, which are pending in the application.
8. The examiner notes that claim 21 is drawn to a composition comprising the hydrogel of claim 1. Therefore the examiner is grouping claim 21 with the product claims of Group I, claims 1, 1 and 15 for examination on the merits.

The requirement is still deemed proper and is therefore made FINAL.

9. Claims 3-11, 17-20 and 22-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 29, 2008.

Status of the claims

10. Claims 12-14 and 16 are cancelled, claims 1-11 and 17-23 are pending in the application, claims 3-11, 17-20 and 22-23 are withdrawn from consideration as being drawn to nonelected inventions, claims 1-2, 15 and 21 are examined on the merits.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for only those hydrogels described in the instant Specification on pp. 10-12 and only those hydrogels are supported by the Specification, does not reasonably provide enablement for any hydrogel having a floatability, as presently claimed in claim 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or practice the invention commensurate in scope with these claims.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the only pertinent limitation of the hydrogel is “A hydrogel having

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a floatability”, the remainder of the text of the claim pertains to the application of the hydrogel to the blood and the process of how the blood or other body fluid is thickened.

Claim Rejections - 35 USC § 102/103

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Engelhart et al (US 4,931,497 A).

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19. With respect to claim 1, Engelhart discloses hydrogels which are substantially identical in structure and composition and are produced in the substantially identical manner as the instant claimed hydrogel and disclosed in the instant Specification at pp. 10-12 as a suitable embodiment of the instant claimed invention; therefore, based on the structure recited in the reference being substantially identical to that of the claims, absent evidence to the contrary, claimed properties or functions are presumed to be inherent. See MPEP § 2112.01.

20. Once a reference teaching a product appearing to be substantially identical is made the basis of a rejection, and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference. “[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency’ under 35 U.S.C. 102, on prima facie obviousness’ under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)). See MPEP § 2112.

21. Therefore the burden of proof has thus shifted to applicant to come forward with evidence establishing that the prior art products do not necessarily or inherently possess the characteristics of the claimed product. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

22.

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23. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Engelhart et al (US 5,041,496 A).

24. With respect to claim 1, Engelhart '496 is applied under the same analysis as Engelhart '496, see paragraphs 19-21, *supra* for detailed analysis.

25.

26. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Engelhart (US 5,011,892 A).

27. With respect to claim 1, Engelhart '892 is applied under the same analysis as Engelhart '496, see paragraphs 19-21, *supra* for detailed analysis.

28. Claims 1, 2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benson et al (US 5,092,858).

29. With respect to claim 1, Benson teaches a hydrogel having a floatability (fig. 1). With respect to the limitations of wherein a solution of suspension to be thickened is thickened starting from the surface of a liquid and the rest of the solution or suspension to be thickened is thickened starting from the bottom of a container for the solution or suspension, the examiner notes that these are not the limitations of the hydrogel, but the limitations of the process of using.

30. With respect to claim 2, Benson discloses the claimed invention except for expressly teaching a solidification time is less than 120 seconds. Benson teaches that each increment of solution is "immediately gelled" (c. 2, l. 56 and ll. 58-59) and "immediately gelled simultaneously" (c. 6, ll. 9-10). The dictionary definition of "immediately", *inter alia*, "without interval of time", "at once: without delay or without pausing beforehand". Therefore, absent

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evidence to the contrary, the solidification time taught by Benson is reasonably interpreted as immediately without an interval of time, which is less than 120 seconds.

31. With respect to claim 15, no structure is previously disclosed for a hygiene article, and therefore the hydrogel fulfills the claimed limitation of a hygiene article. The hydrogel is fully capable of functioning as an absorbent material for absorbing solutions comprising blood or bodily fluid contained in a container and a hygiene article and therefore meets the claimed limitations.

32. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benson in view of Lepore et al (WO 98/42193).

33. With respect to claim 21, Benson discloses the claimed invention except for one or more biocidal materials. Lepore teaches a composition comprising a hydrogel (p. 4, l. 33) and biocidal and antimicrobial materials (p. 3, ll. 1-24). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the composition of Benson comprising biocidal and antimicrobial materials since Lepore states, at p. 3, ll. 21-22 and at p. 6, ll. 32-33, that the benefit of providing such materials in the composition is the elimination of hazardous pathogens in hospital room containers used to capture bodily fluids during surgery, thereby reducing the hazards of handling such fluids.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T. Chapman whose telephone number is (571)272-4934. The examiner can normally be reached on Monday through Friday 9:30 a.m. to 6:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ginger T Chapman/
Examiner, Art Unit 3761
11/13/08

/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit 3761